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BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Paper No. 13

Application Number: 09/510,569
Filing Date: February 22, 2000
Appellant(s): TADOKORO ET AL.

Antony P. Ng.
For Appellant

EXAMINER'S ANSWER

MAILED

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Technology Center 2100

This is in response to the appeal brief filed June 16, 2003.

(1) ***Real Party in Interest***

A statement identifying the real party in interest is contained in the brief.

(2)   ***Related Appeals and Interferences***

A statement identifying the related appeals and interferences which will directly affect or

be directly affected by or have a bearing on the decision in the pending appeal is contained in the

brief.

(3)   ***Status of Claims***

The statement of the status of the claims contained in the brief is correct.

(4)   ***Status of Amendments After Final***

The appellant's statement of the status of amendments after final rejection contained in

the brief is correct.

(5)   ***Summary of Invention***

The summary of invention contained in the brief is correct.

(6)   ***Issues***

The appellant's statement of the issues in the brief is correct.

(7)   ***Grouping of Claims***

Appellant's brief includes a statement that claims 1-8 and 17-20 or fall together and

provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8).

(8)   ***Claims Appealed***

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9)   ***Prior Art of Record***

6,324,644   Rakavy et al   11-2001

(10)   Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 102

1.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the

basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999

(AIPA) do not apply to the examination of this application as the application being examined

was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C.

122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment

by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

2.   Claim 1-8 and 18-19 are rejected under 35 U.S.C. 102(e) as being anticipated by US

Patent No.6, 324,644 by Rakavy et al.

In claim 1, Rakavy teaches about a method for performing a hardware setup operation on

a data processing system, said method comprising (Col 4, lines 1-35):

storing a hardware setup program and a plurality of dynamic link modules in a server

data processing system (Col 10, lines 50-55 0;

coupling a data processing system to said server data processing system via a data

processing system network(Col 9, lines 1-5);

in response to a request to execute said hardware setup program by said data

processing system, executing said hardware setup program within said server data

processing system (Col 4, lines 25-35);

modifying hardware configuration data within said data processing system

according to instructions generated from said execution of said hardware setup program within

said server data processing system (Col 4, lines 25-35); and

de-coupling said data processing system from said server data processing system

after a completion of said hardware setup operation (Col 11, lines 1-30).

For claim 2, Rakavy teaches about a method of Claim 1, wherein when said hardware

setup operation required by said data processing system exists within an operating system

running on said data processing system, said hardware setup program performs said hardware

setup operation by using a service a provided by said operating system. (Col 11, lines 30-40).

In claim 3, Rakavy teaches about a method of Claim 1, wherein when said hardware

setup operation required by said data processing system does not exist within an operating

system running on said data processing system, said hardware setup program calls a BIOS

program within said data processing system to perform said hardware setup operation (Col 9,

lines 1-10).

For claim 4, Rakavy teaches about a method of Claim 1, wherein said method further

includes transferring one or more of said dynamic link modules from said server data processing

system to said data processing system via said data processing system network as a result of said

execution of said hardware setup program. (Col 10, lines 60-67).

In claim 5, Rakavy teaches about an apparatus for performing a hardware setup operation on a data processing system, said apparatus comprising:

means for storing a hardware setup program and a plurality of dynamic link modules in a server data processing system (Col 10, lines 50-55);

means for coupling a data processing system to said server data processing system via a data processing system network (Col 9, lines 1-5);

means for executing said hardware setup program within said server data processing system, in response to a request to execute said hardware setup program by said data processing system (Col 4, lines 25-35);

means for modifying hardware configuration data within said data processing system according to instructions generated from said execution of said hardware setup program within said server data processing system (Col 4, lines 30-35); and

means for de-coupling said data processing system from said server data processing system after a completion of said hardware setup operation (Col 11, lines 1-30).

For claim 6, Rakavy teaches about an apparatus of Claim 5, wherein when said hardware setup operation required by said data processing system exists within an operating system running on said data processing system, said hardware setup program performs said hardware setup operation by using a service provided by said operating system (Col 11, lines 30-40).

In claim 7, Rakavy teaches about an apparatus of Claim 5, wherein when said hardware setup operation required by said data processing system does not exist within an operating system running on said data processing system, said hardware setup program calls a BIOS

program within said data processing system to perform said hardware setup operation (Col 9, lines 1-10).

For claim 8, Rakavy teaches about an apparatus of Claim 5, wherein said apparatus further includes means for transferring one or more of said dynamic link modules from said server data processing system to said data processing system via said data processing system network as a result of said a execution of said hardware setup program (Col 10, lines 60-67).

For claim 17, Rakavy teaches about a computer program product for performing a hardware setup operation on a data processing system, said computer program product comprising (Col 4, lines 1-35):

program code means for storing a hardware setup program and a plurality of a dynamic link modules in a server data processing system (Col 10, lines 55-60);

program code mean for coupling a data processing system to said server data processing system via a data processing system network(Col 9, lines 1-5);

program code means for executing said hardware setup program within said server data processing system, in response to a request to execute said hardware setup program by said data processing system (Col 9, line 60-Col 10, line 55);

program code means for modifying hardware configuration data within said data processing system according to instructions generated from said execution of said hardware setup program within said server data processing system (Col 4, lines 25-35); and

program code means for de-coupling said data processing system from said server data processing system after a completion of said hardware setup operation (Col 11, lines 1-30).

For claim 18, Rakavy teaches about a computer program product of Claim 17, wherein when said hardware setup operation required by said data processing system does not exist within an operating system running on said data processing system, said hardware setup program calls a BIOS program within said data processing system to perform said hardware setup operation (Col 11, lines 30-40).

In claim 19, Rakavy teaches about a computer program product of Claim 17, wherein when said hardware setup operation required by said data processing system does not exist within an operating system running on said data processing system, said hardware setup program calls a BIOS program within said data processing system to perform said hardware setup operation (Col 9, lines 1-10).

In claim 20, Rakavy teaches about a computer program product of Claim 17, wherein said computer program product further includes program code means for transferring one or more of said dynamic link modules from said server data processing system to said data processing system via said data processing system network as a result of said execution of said hardware setup program (Col 10, lines 60-67).

Examiner's summary of prior art

A network enhanced BIOS on a local computer is used to initiate a connection with a remote server. The network enhanced BIOS when enable, causes the local computer to be connected to a remote server whenever an upgrade is needed or a fault occurs. The remote server after being connected, downloads a set of programs that are stored in the network enhanced BIOS and RAM. These programs allow the remote server to take control of the local computer.

From the remote server, diagnostic can be run and the hardware setup program can be modified.

If the diagnostic and hardware setup is successful, the network enhanced BIOS ceases to

communicate with the remote server and the control of the local computer is return to the local

computer. The information stored in the network enhanced BIOS will be used in the bootstrap

operation that passes control to the operating system.

(11)   Response to Argument file June 12, 2003

Appellants argued in substance that:

a.   Rakavy does not teach or suggest the claim storing step

b.   Rakavy does not teach or suggest the claim storing coupling or de-coupling

c.   Rakavy does not teach or suggest the claim modifying step

In reply to argument (a) "Rakavy does not teach or suggest the claim storing step",

Rakavy patent teaches about a loader service that is used during the setup period. This loader

service causes a workstation (200) (server data processing system)(Col 10, lines 55-60) to

transfer code and data (hardware setup program and dynamic link modules) from its location to a

RAM located on a computer (400) (data processing system)(Col 5, lines 30-60). For this

operation to have taken place, it is inherent that the code and data (hardware setup program and

dynamic link modules) had to be stored in advance on the workstation (server data processing

system) for this operation to be possible.

The code and data that are loaded from a remote server (Col 10, line 50-55) is consistent

with a "hardware setup program". During the course of setting up, it is well known in the art that

the codes and data that are downloaded are mainly used in the setup of the hardware in

preparation for the operation of the operating system (Col 3, lines 1-15). If there was no hardware setup, the operation system cannot interact with the hardware and will be non functional. The dynamic links (additional software, diagnostic) are the associated programs that are used in conjunction with the hardware setup programs (Col 3, lines 1-15), (Col 4, lines 1-35), (Col 17, lines 45-67), (Col 10, line 50-55) (See page 13-14 of specification). After network connection (coupling), all controls are passed to the remote workstation (server data processing system), which is evident, by the redirecting of the Keyboard, Screen and disk (Col 9, line 60-Col 10, line 67). The act of redirecting after the connection (coupling) is setup reaffirms that none of the hardware setup program or dynamic links that is used in the hardware setup procedure, originates from the computer 400 (data processing system).

In reply to argument (b) "Rakavy does not teach or suggest the claim storing coupling or de-coupling", Rakavy teaches about making the electronic connection (Coupling) between the workstation (200) (server data processing system) and computer (400) (data processing system) (Col 5, lines 5-30) and removing the electronic connection (decoupling) from computer (400) after a successful hardware setup is completed (Col 11, lines 1-30). The act of passing control to CPU 110, shows that the computer (400) is able to operate on its own and no longer need to be electronically connected with the remote workstation (200) as indicated by the network enhanced BIOS ceasing to function (Col 11, lines 20-30). By ceasing to function, computer (400) is disconnected electronically from the workstation (200) which means that it is decoupled from the network.

The word "physically" was not used in any of the claims and will not be considered in the response.

In reply to argument (c) "Rakavy does not teach or suggest the claim modifying step",

Rakavy teaches about a means in which command, status and data are transferred between a first

computer (400) and a second computer (200). A command is issued to create an action or bring

about a change, while status is used as a means to verify that the intended action or change is

executed as commanded (Col 4, lines 30-35). These functions are only used together when the

intention of the user is to modify the hardware. Whenever a fault has occurred in hardware, the

only way it can be fixed is by modifying the hardware.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

MD
July 2, 2003

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